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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,309	07/01/2004	David S. Bonalle	70655.1500	4308
20322	7590	07/19/2005		
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			EXAMINER WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/710,309	Applicant(s) BONALLE ET AL.	
	Examiner Daniel I. Walsh	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-04, 8-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Receipt is acknowledged of the IDS received on 1 July 2004 and 5 August 2004.

Double Patenting

2. Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35, 36, 38-41, 43, and 45-47 of copending Application Nos. 10/708,825, 10/708,826, 10/708,827, 10/708,833, 10/708,835, 10/708,836, 10/710,310, 10/710,311, 10/710,315, 10/710,326, 10/710,328, and 10/710,329, claims 34, 35, 37-40, 42, and 44-46 of copending Application No. 10/708,828, 10/708,830, 10/708,831, 10/708,832, 10/708,834, 10/710,317, 10/710,323, 10/710,324, 10/710,325, and 10/710,327, claims 36, 37, 39-42, 44, and 46-48 of copending Application No. 10/710,319,

Claims 1, 3, and 5-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, and 6-9 of copending Application Nos. 10/710,334.

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application Nos. 10/708,824.

Claims 1-5 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 8 of copending Application Nos. 10/710,307.

Claims 1-4 and 5-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 6, and 8 of copending Application Nos. 10/710,307.

Claims 1 and 7 -10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of copending Application Nos. 10/708,823.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the '309 Patent Application is a broader recitation of the '311 Patent Application. For instance:

In claim 1 of the present claimed invention and claim 35 of the '311 Patent Application the Applicants claim:

i) "...smartcard transaction system...proffered biometric...verifying...authorizing..." (see claim 1), whereas in the '311 Patent Application the Applicants claim "...smartcard transaction system...proffered facial scan...verifying...authorizing a transaction." (see claim 35). The Examiner notes that a facial scan is a type of biometric.

In claim 2 of the present claimed invention and claim 36 of the '311 Patent Application the Applicants claim:

ii) "...one of a smartcard, a reader, and a network." (see claim 2), whereas in the '311 Patent Application the Applicants claim "...one of a smartcard, reader, and network." (see claim 36).

In claim 3 of the present claimed invention and claim 38 of the present claimed invention the Applicants claim:

iii) "...detecting includes at least one of detecting..." (see claim 3), whereas in the '311 Patent Application the Applicants claim "...detecting includes at least one of detecting..." (see claim 38).

In claim 4 of the present claimed invention and claim 39 of the '311 Patent Application the Applicants claim:

iv) "...finite number of proffered biometric sample..." (see claim 4), whereas in the '311 Patent Application the Applicants claim "...finite number of proffered facial scan samples." (see claim 39). The Examiner notes it is well known and conventional to receive biometric samples via scans.

In claim 5 of the present claimed invention and claim 40 of the '311 Patent Application the Applicants claim:

v) "...logging each proffered biometric sample." (see claim 4), whereas in the '311 Patent Application the Applicants claim "...logging each proffered..." (see claim 40).

In claim 6 of the present claimed invention and claim 41 of the '311 Patent Application the Applicants claim:

vi) "...second proffered biometric sample." (see claim 6), whereas in the '311 Patent Application the Applicant claims "...second proffered facial scan sample." (see claim 41).

In claim 7 of the present claimed invention and claim 43 of the '311 Patent Application the Applicants claim:

vii) "...with a stored biometric sample..." (see claim 7), whereas in the '311 Patent Application the Applicants claim "...with a stored facial scan sample." (see claim 43).

In claim 8 of the present claimed invention and claim 45 of the '311 Patent Application, the Applicants claim:

viii) "...criminal, a terrorist, and a cardmember." (see claim 8), whereas in the '311 Patent Application the Applicants claim "...criminal, a terrorist, and a card member." (see claim 45).

In claim 9 of the present claimed invention and claim 46 of the '311 Patent Application the Applicants claim:

ix) "...local database, a remote database, and a third party controlled database." (see claim 9), whereas in the '311 Patent Application the Applicants claim "...local database, a remote database, and a third party controlled database." (see claim 46).

In claim 10 of the present claimed invention and claim 47 of the '311 Patent Application the Applicants claim:

x) "...local CPU and a third party security vendor." (see claim 10), whereas in the '311 Patent Application the Applicants claim "...local CPU and a third party security vendor." (see claim 47).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Re the additional Applications listed above, the Examiner notes that they are rejected in the same manner as discussed above with regard to the '311 Patent Application, as they all merely recite obvious types of biometrics used in verification of smartcard transactions. The 10/708,xxx series of patent applications, though drawn to a transponder and not a smartcard, are also rejected in the same manner. The Examiner notes that the use of a transponder in place of smart card is obvious to one of ordinary skill in the art (see teachings of Black below, which recite either a transponder, card, or other type of wireless device maybe used to facilitate biometric verification for a transaction.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(e) as being 10 by Black (US 2005/0122209).

Re claim 1, Black teaches detecting a proffered biometric at a sensor communicating with the system to obtain a proffered biometric sample; verifying the proffered biometric sample and authorizing a transaction upon verification of the proffered biometric sample (FIG. 1C and abstract).

Re claim 2, Black teaches the step of detecting included detecting a proffered biometric at a sensor configured to communicate with the system via at least one of a smartcard, reader, and network (FIG. 1C).

Re claim 3, Black teaches the step of detecting includes at least one of detecting, storing, and processing a proffered biometric sample (FIG. 1C and abstract).

Re claim 4, FIG. 1C shows a finite number of biometric samples are detected (fingerprint, signature).

Re claim 5, in Black teaches storing of digital and electronic signatures for record keeping purposes (paragraph [0125]). Additionally, the Examiner notes that biometric samples are stored/logged at least temporarily in other embodiments, just to compare/verify. The Examiner also notes McCall et al. (US 2003/0132297) which store/log signatures, Haala et al. (US 2005/0102524) which teaches recording details if authentication fails, and Segal et al. (US 2002/0066784) which teaches that a signature is bundled with transaction data and stored in a database to effect proof of a transaction.

Re claim 6, Black teaches the step of detecting includes at least one of detecting, processing, and storing at least one second proffered biometric sample (FIG. 1C), which teaches both a signature and fingerprint.

Re claim 7, FIG. 1C teaches comparing a proffered biometric to a stored biometric.

Re claim 8, the Examiner notes that the proffered biometric is indeed compared with a sample of at least one of a criminal, a terrorist, and a cardmember (which should be the current card member) to authorize the transaction.

Re claim 10, as the reference data/signature is stored on the wireless card/transponder/device itself, it is obvious that the card reader processor verifies the sample, and is interpreted as one of a local CPU and third party security vendor.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black.

The teachings of Black have been discussed above.

Re claim 9, Black teaches an embodiment where a transponder has information (fingerprint) stored on the device itself, and another embodiment where the signature is stored remotely (paragraph [0090]+) for security reasons. Accordingly, it is obvious that such data storage can be applied to a smartcard, as Black has already taught that the invention can relate to smartcard, transponders, etc. Therefore, it is obvious that the biometric sample would be verified using information contained remotely, such as in the instance when the signature is stored remotely (at customers bank). Though silent to the use of a database, the examiner notes that the use of a database as an obvious expedient for storing and accessing data on a computer device has been discussed above, and is obvious in order to have a means to access and retrieve data, well known in the art.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hoshino (US 6,636,620), which teaches the facilitating transactions with a biometric card, Hillhouse et al. (US 2003/0223625), Kim (US 2002/0087869), Yamaguchi et al. (US 2001/0036301), Fuji et al. (US 6,233,348), Bogosian, Jr. (US re36580), Doughty et al. (US 2005/0001711), Ezaki et al. (US 2003/0037264), Hewel (US 2005/0103839), Berardi et al. (US 2004/0118930), Roberts et al. (US 5,438,184), Nestor et al. (US 2004/0006497), Deaton (US

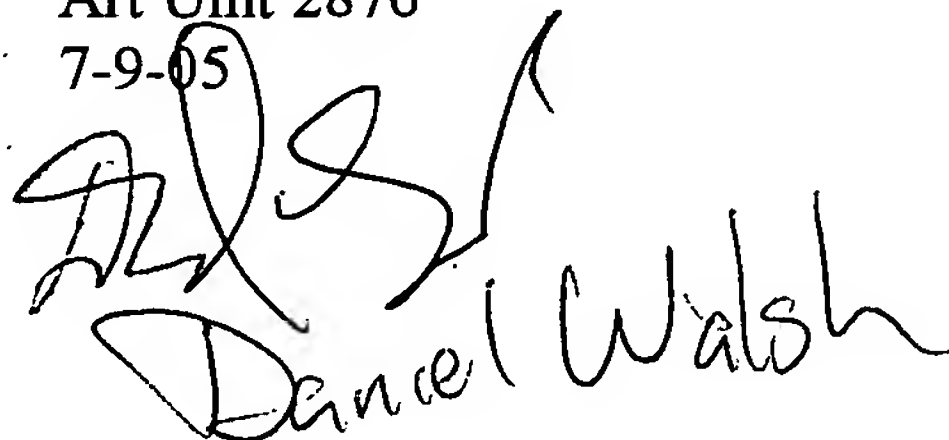
2002/0179704), Loof (US 2002/0186133), Saltz (US 2005/0149926), Royer et al. (US 2004/0155101), Janke (US 2004/0083380), Antonucci (US 2003/0236704), D'Arbeloff et al. (US 2003/0009382), Garcia (US 2003/0125054), Geiselman et al. (US 2002/0072349), Schick et al. (US 5,180,902), and Yu et al. (US 2005/0097038).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
7-9-05

A handwritten signature in black ink, appearing to read "Daniel I. Walsh", is written over the typed name and date.